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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,090	09/19/2006	Theodore J. Stone	1366US2	3971
25279 7590 03/06/2009 GRACO MINNESOTA INC PO BOX 1441 MINNEAPOLIS, MN 55440				
EXAMINER				
NGO, LIEN M				
ART UNIT		PAPER NUMBER		
3754				
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03/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,090

Applicant(s)

STONE ET AL.

Examiner

LIEN TM NGO

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed 6/2/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

“In the method of the instant invention shown in Figure 1, the system first dispensing a plurality of doses of plural component material measures the ratio between said components in the plurality of doses and calculates the number of on-ratio doses that are within the predetermined fixed ratio tolerance (4% in the preferred embodiment.) It then determines the number of the doses which fall within a predetermined tolerance level of the desired ratio by asking are more than 98% (in the preferred embodiment) of the doses within that tolerance. When the number of on-ratio doses are more than 98% of the total, the dose size is decreased. This step sequence is shown in the first major branch of the flow chart of Figure 1. Similarly, it determines the number of the doses which fall outside a predetermined tolerance level of the desired ratio by asking are less than 90% (in the preferred embodiment) of the doses within that tolerance. When the number of on-ratio doses are less than 90% of the total, the dose size is increased. This step sequence is shown in the second major branch of the flow chart of Figure 1.”

The flow chart of Figure 1 does not disclose “the system first dispensing a plurality of doses of plural component material measures the ratio between said components in the plurality of doses”, “predetermined fixed ratio tolerances”, “preferred embodiment”. “a predetermined tolerance level of desired ratio”, “the number of on-ratio doses”, etc.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The disclosure is objected to because of the following informalities: the disclosure of the present application is incomplete.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. In re Glass, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques, where necessary, as to enable those persons skilled in the art to make and utilize the invention. Specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. Applicant's disclosure is merely a series of steps (as shown by the drawings/flow chart) without specific means to implement. For example, what is the device/structure that performs "dispensing, measuring the ratio, determining the number, increasing, etc...?"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim subject matter of claims 1- 3 are not supported in the Specification and Drawing because the original Specification and Drawing do not support "a method of setting dose size for a plural component sequential metering system for dispensing material having at least first and second components", "dispensing a plurality of doses of plural component material", "measuring the ratio between said components in said plurality of doses", "determined the number of said plurality which fall within a predetermined tolerance of the desired ratio", "increasing said dose size when the number of doses falling outside said predetermined tolerance exceeds a predetermined level", as in claim 1.

And "a method of setting dose size for a plural component sequential metering system for dispensing materials having at least first and second components", "dispensing a plurality of doses of plural component material", "measuring the ratio between said components in said plurality of doses", "determining the number of said plurality which fall within a predetermined tolerance of the desired ratio", and "decreasing said dose size when the number of closes falling outside said predetermined tolerance is within a predetermined level"; as in claim 3.

5. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
6. The specification does not disclose sufficient scope as to justify the scope of the claims. Applicant's disclosure is merely a series of steps (as shown by the drawings/flow chart) without specific means to implement. For example, what is the device/structure that performs "dispensing, measuring the ratio, etc...?"

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (a particular machine or apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim ***should positively recite*** the other statutory class (the thing or product) to which it is tied, ***for example*** by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, ***for example*** by identifying the material that is being changed to a different state.

The step requires a particular machine or apparatus such that the step cannot be performed mentally or manually in a manner that reasonably accomplishes the intended purpose of the recited invention, as claimed, without the use of a structure.

9. Claims 1-3 does not identify the apparatus that accomplishes the method steps, and the material that is being changed to a different state.

Response to Arguments

10. Applicant's arguments filed 12/5/08 have been fully considered but they are not persuasive as pointed out in the rejections above.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIEN TM NGO whose telephone number is 571-272-

4545. The examiner can normally be reached on Monday through Friday from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KEVIN SHAVER can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LIEN TM NGO/
Primary Examiner, Art Unit 3754

March 3, 2009